

### **REMARKS**

Claims 42-45, 51 and 53-74 were previously pending in this application. Claims 53-57 and 62-73 are now cancelled without prejudice or disclaimer. No claims are amended. No new claims are added. Claims 42-45, 51, 58-61 and 74 are pending for examination with claim 42 being an independent claim.

No new matter has been added.

#### ***Interview with Examiner:***

Applicant thanks Examiner Epps-Ford for the courtesy extended during the personal interview with Applicant's representative Helen Lockhart on October 13, 2006. During the Interview the issues of the Restriction Requirement and Double Patenting were discussed. Applicant's representative agreed to cancel the method claims and pursue the product claims 42-45, 51, 58-61 and 74 in the pending application. The method claims will be pursued in a divisional application. It was agreed that the Obviousness-type double patenting rejection would be withdrawn in view of the restriction requirement presented in parent patent application US 08/960,774, now issued as US6,239,116B1.

#### ***Defective Oath or Declaration:***

A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date and listing the updated corrected priority information is enclosed.

#### ***Election/Restrictions:***

In view of the cancellation of method claims 53-57 and 62-73 the restriction requirement is now moot. Reconsideration and withdrawal of the rejection is respectfully requested.

#### ***Double Patenting***

Claims 42-61 and 74 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of U.S. Patent No. 6,239,116 B1. Attached is a copy of the restriction requirement received from the US Patent Office in parent application US


08/960,774, now issued as US6,239,116B1. The Restriction requirement requires the election between product and method claims. Additionally, Applicants have now canceled all method claims from the instant patent application. It is believed that the amendments and evidence presented herein is sufficient to overcome the rejection.

**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: October 17, 2006

Respectfully submitted,

By 

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**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/960,774	10/30/97	KRIEG	A 08918/012001

LAH  
FISH AND RICHARDSON  
4225 EXECUTIVE SQUARE  
SUITE 1400  
LA JOLLA CA 92037

HM22/0308

EXAMINER	
MARTINELL, J	
ART UNIT	PAPER NUMBER
1633	9

DATE MAILED: 03/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

RECEIVED

MAR 15 1999

FISH & RICHARDSON

Docketed By Practice Systems	
Action Code:	Restriction
Base Date:	3/8/99
Due Date:	4/8/99
Deadline:	9/8/99
Initials:	AW
Record:	

g Secretary

DOCKETED

MAR 25 1999

C1039/7005

File Folder	<input checked="" type="checkbox"/>	Initials
ECB	<input checked="" type="checkbox"/>	
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4.8.99



# Office Action Summary

Application No.  
08/960,774

Applicant(s)  
Krieg et al

Examiner  
James Martinell

Group Art Unit  
1633



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-41 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial No. 08/960,774

Art Unit 1633



Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to oligonucleotides, classified in class 536, subclass 22.1.
- II. Claims 18-35, drawn to methods of treatment using oligonucleotides, classified in class 514, subclass 44.
- III. Claims 36-41, drawn to methods of treatment using bafilomycin A, chloroquine, or monensin, classified in class 544.

The oligonucleotides of Group I can be used for methods other than the methods of Group II (e.g., as building blocks for the synthesis of longer amino acids). The oligonucleotides of Group I are not needed to practice the methods of Group III. The methods of Groups II and III may be practiced independently of one another.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized